

REMARKS/ARGUMENTS

Claims 1-8, 10-12, and 14-34 are pending in this application. Claims 1, 2, 10, 14, 23, 29, and 32 have been amended without prejudice and without acquiescence. Support for the amendments is found on page 3, lines 14-21 of the specification, where the properties of nicotine and oxygen barriers are described. Additional support for the amendments is found within the specification on page 6, line 12, which describes films and laminates of the polymers of the present invention. No new matter has been added.

The issues outstanding in this application are as follows:

- Claims 1-8, 10-12, and 14-34 are rejected under 35 U.S.C. § 112 for indefiniteness.
- Claims 1-3, 5-8, 10-12, and 14-34 are rejected under 35 U.S.C. § 103(a) as being obvious over Cubbage et al. (U.S. Patent No. 5,804,215) in view of Kashimura (U.S. Patent No. 5,326,848).

I. Claims 1-8, 10-12, and 14-34 are definite

The Examiner has rejected claims 1-8, 10-12, and 14-34 under 35 U.S.C. § 112 for indefiniteness. The Examiner contends that the naphthalanate-based polymer does not comprise a barrier and employs a laminate. Applicants respectfully traverse. Applicants point to page 5, lines 11-13, of the specification, which states, "...in addition to the above-mentioned barrier properties against water and oxygen PEN, PTN, and LCP also exhibit excellent barrier properties against nicotine." Applicants further note that on page 6 of the specification, line 12 states that the polymers may be used in a film application, and thus do not necessarily form a laminate.

Applicants have amended claims 1, 2, 10, 14, 23, 29, and 32 without prejudice or acquiescence in order to advance prosecution of the present application. Claims 1-8, 10-12, and 14-34 are definite. In light of the above amendments, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection.

II. Claims 1-3, 5-8, 10-12, and 14-34 are nonobvious over Cubbage.

The Examiner has rejected claims 1-3, 5-8, 10-12, and 14-34 under 35 U.S.C. § 103(a) as being obvious over Cubbage *et al.* (U.S. Patent No. 5,804,215) in view of Kashimura *et al.* (U.S. Patent No. 5,326,848). Applicants respectfully traverse.

1. References lack motivation to combine.

Cubbage *et al.* teaches a terephthalate-based polyester, but does not teach naphthalate-based polyesters in packages for transdermal nicotine patches. Kashimura *et al.* teaches oxygen gas barrier properties of thermotropic liquid crystal polyesters, but does not teach packaging nicotine-containing products.

Applicants respectfully reiterate that a claim is considered obvious only if the claimed invention as a whole would have been obvious to a skilled artisan. *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997). “It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). When relying on a modification of the prior art to reject a claim, it is incumbent upon the Examiner to identify some suggestion in the prior art to make the modification. *In re Mayne*, 104 F.3d at 1342. Although Cubbage *et al.* teaches products to dispose of nicotine-containing products, there is no suggestion in Cubbage *et al.* that an oxygen gas barrier is required in such a disposal system. The Examiner must point to some suggestion in Cubbage *et al.* that the modification should be made. The Examiner has stated that the motivation to combine the references may be found in column 3, lines 36-40 of Kashimura *et al.* Kashimura *et al.*, however, merely indicates the oxygen gas barrier properties of thermotropic liquid crystal polyesters. A mere statement of the characteristics of Kashimura *et al.* is not a motivation to combine with Cubbage *et al.* There is no suggestion in Kashimura *et al.* that oxygen barrier properties are desirable for nicotine transdermal patch disposal. Additionally, the Examiner has not found any specific suggestion in Cubbage *et al.* that such a combination is desirable, and thus has failed to establish a *prima facie* case of obviousness.

2. Cabbage *et al.* teaches away from the combination of the references.

Teaching away from the art is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

Applicants respectfully assert that, given that this reference is inappropriate, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731,743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Cabbage *et al.* teaches a method of disposal, aimed at protecting children or pets from nicotine ingestion. Applicants teach a packaging system, aimed at protecting nicotine from environmental exposure. Inherent in the disposal system of nicotine transdermal patches in Cabbage *et al.*, there is no suggestion that the nicotine remain biologically active, and thus protected from reaction with oxygen. Thus, there is no suggestion in Cabbage *et al.* that an oxygen gas barrier is desirable. In fact, such an oxidative reaction is advantageous in the disposal system of Cabbage *et al.*, whereby reaction with oxygen would assist in the breakdown of nicotine. As paraphrased from Merriam-Webster, “disposal” indicates destruction or transformation of garbage. Thus, oxygen is in fact an agent which assists in the destruction, or disposal, of nicotine. Cabbage *et al.* teaches away from the modification of the invention to include oxygen gas barrier properties, as such a modification would hinder disposal of the nicotine transdermal patch.

In contrast, Applicants teach a nicotine and oxygen gas barrier in order to contain nicotine in a biologically active form and keep out environmental gases.

In light of the above arguments, Applicants respectfully request withdrawal of the 35 U.S.C § 103(a) rejection.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. 10105701 from which the undersigned is authorized to draw.

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Respectfully submitted,

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